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EXAMINER

CHANKONG, DOHM

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/731,758	Applicant(s) FACCIN ET AL.	
	Examiner DOHM CHANKONG	Art Unit 2452	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 1,7-9,87,88 and 92-100 is/are pending in the application.
- 5a) Of the above claim(s) 97-100 is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☐ Claim(s) ____ is/are rejected.
- 8) ☒ Claim(s) 1,7-9,87,88 and 92-96 is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/13/2011</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

This non-final rejection is in response to Applicant's amendment and arguments filed on 7/15/2011. Applicant amends claims 1, 7-9, 87, 88, and 92-96, adds claims 97-100, and previously cancelled claims 2, 3, 17-31, and 33-84. Accordingly, Applicant presents claims 1, 4-16, 32, and 85-100 for further examination.

I. ELECTION BY ORIGINAL PRESENTATION

MPEP § 821.03 provides that "[c]laims added by amendment following action by the examiner...to an invention other than previously claimed, should be treated as indicated by 37 CFR 1.145." 37 CFT 1.145 provides that:

"[i]f, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in §§ 1.143 and 1.144."

Here, newly submitted claims 97-100 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the new claims are directed to a different invention from the original claims. Specifically, claim 97 discloses the features of (1) transmitting, by a user equipment, a first message comprising a request for application level registration and (2) in response to transmitting the first message, receiving, at the user equipment, a second message comprising a selected subscriber profile.

These features are independent and distinct from any of the features found in the original claims. For example, claim 1 recites sending a subscriber id and a requested type of access to be provided to a subscriber (not an application level registration) and storing a selected subscriber profile in the visited network (not at the user equipment).

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Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 97-100 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

II. INFORMATION DISCLOSURE STATEMENT

The examiner has considered the information disclosure statement filed on 9/13/2011.

III. RESPONSE TO ARGUMENTS

Applicant's arguments with respect to claims 1, 4-16, 32, and 85-96 have been considered but are moot in view of the new ground(s) of rejection.

IV. CLAIM REJECTIONS – 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

A. **Claims 1, 6, 9, 12-16, 85, and 87 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Pepe* et al., U.S. Patent No. 5,742,668 [*“Pepe”*] in view of *Chow* et al., U.S. Patent No. 6,445,911 [*“Chow”*].**

Claims 1, 85, and 87

As to claim 1, *Pepe* as modified by *Chow* discloses a method of controlling access of a subscriber to a network comprising:

sending, from a visiting network comprising at least one server [*Pepe*, column 2 «lines 16-37»] to a home network, an identification of the subscriber and a requested level or type of access to be provided to the subscriber [*Pepe*, column 2 «lines 19-37» | column 6 «lines 10-15 and 47-52»: disclosing validating subscriber's request & *Chow*, column 7 «line 61» to column 8 «line 21»: disclosing a users have authorizations to access different types of services];

in response to the sending, storing in the visited network a selected subscriber profile [*Pepe*, column 2 «lines 19-37»: disclosing storing the profile in the visiting network] selected from a plurality of subscriber profiles for the subscriber [*Chow*, column 7 «line 61» to column 8 «line 21»: disclosing a user may have multiple service profiles based on the services to which the subscriber is subscribed], in which the selected subscriber profile comprises an authorization for an authorized level or type of access [*Chow*, column 8 «lines 5-43»: disclosing that the specific service profile describes the type of service access available to the user]; and

the visited network controlling access of the subscriber to services provided through the visited network dependent upon a comparison of the requested level or type of access and the authorized level or type of access in the stored subscriber profile [*Pepe*, column 2 «lines 19-37» | column 6 «lines 11-27» and 47-59»].

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As noted in the foregoing mapping, *Pepe* does not expressly disclose that one subscriber may have multiple profiles in the home network. However, such a feature was well known in the art at the time of Applicant's invention as evidenced by *Chow*.

Like *Pepe*, *Chow* is directed to an invention for providing access to services to a subscriber in a visited network [*Chow*, column 1 «lines 46-67»]. *Chow* further discloses that a subscriber may establish multiple profiles that specify different types of access to services based on, for example, the user's location [*Chow*, column 8 «lines 23-42»].

It would have been obvious to one of ordinary skill in the art to have modified *Pepe*'s invention to include multiple profiles for a single subscriber as taught in *Chow*. Such a modification would improve *Pepe*'s system because it would allow a subscriber to establish appropriate profiles for different situations that the subscriber is in.

Claims 85 and 87 are rejected for at least the same reasons set forth for claim 1.

Claim 6, 9, and 12

Pepe as modified by *Chow* discloses the authorized level or type of access authorizes specific connection supplementary services [*Pepe*, column 7 «lines 15-25» & *Chow*, column 8 «lines 23-43»].

Claim 13

Pepe as modified by *Chow* discloses the home network is an internet protocol network and the visited network is a wireless public cellular bearer network [*Pepe*, column 23 «lines 50-60»].

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Claim 14

Pepe as modified by *Chow* discloses the public cellular bearer network is a general packet radio system network [*Pepe*, column 18 «lines 30-40»].

Claim 15

Pepe as modified by discloses the home network is an internet protocol network and the visited network is an internet service provider [*Pepe*, column 2 «lines 58-65» | column 22 «lines 37-41»].

Claim 16

Pepe as modified by *Chow* discloses the home network is an internet protocol network and the visited network is a wireless local area network [*Pepe*, column 23 «lines 28-38»].

B. Claims 4, 7, and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Pepe* and *Chow* in further view of *Lupien*, U.S. Patent No. 5857153.

Pepe as modified by *Chow* and *Lupien* discloses the authorized level or type of access authorizes a specific degree of bandwidth in communications [*Lupien*, column 14 «lines 25-35»: disclosing incorporating bandwidth information for a subscriber | column 11 «lines 21-40»].

It would have been obvious to one of ordinary skill in the art to have modified *Pepe* and *Chow*'s service profiles to include degree of bandwidth information as described in *Lupien*. Modification of a service profile to include additional information concerning the services provided to a subscriber is not a novel step because such a modification is an example of combining prior art elements (*Chow*'s service profile and *Lupien*'s service profile comprising bandwidth information) according to known methods to yield predictable results. See MPEP § 2143.

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C. Claims 5, 8, and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Pepe* and *Chow* in further view of *Rai* et al., U.S. Patent No. 6,377,982 [*"Rai"*].

Pepe as modified by *Chow* and *Rai* discloses the authorized level or type of access authorizes a specific degree of security in communications [*Rai*, column 24 «lines 13-25»: disclosing each subscriber is defined a security context which authorizes a degree of security (e.g., type of encryption) for communications].

It would have been obvious to one of ordinary skill in the art to have modified *Pepe*'s mobile service provisioning system to include *Rai*'s security contexts. Such a modification would improve *Pepe*'s system by allowing subscriber-specific defined security in communications.

D. Claims 32 and 33 are rejected under 35 U.S.C § 103(a) as being unpatentable over *Pepe* and *Chow* in further view of *Hoffman*, U.S Patent No. 6,148,199.

Pepe and *Chow* do not disclose the claimed features in claims 32 and 33. However, in the same field of invention, *Hoffman* discloses:

the identification of the subscriber and the requested level or type of access is sent in an application level registration message that is generated by the visited network in response to a request from subscriber equipment [*Hoffman*, column 1 «lines 31-37»];

in response to an entity in the visited network receiving the request, an address of an entity in the home network is obtained from a routing analysis in the visited network [column 1 «lines 37-41»];

the application level registration message is transmitted to the address in the home network [column 1 «lines 37-41»]; and

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an entity of the home network obtains the subscriber profile in response to receipt of the application level registration message [column 1 «lines 31-41»].

It would have been obvious to one of ordinary skill in the art to incorporate *Hoffman*'s well known teachings into *Pepe*'s system. One would have been motivated to provide such a combination because such functionality is well known in the art for providing subscriber profiles to visited networks from home networks.

E. Claims 86, 88, and 89 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Pepe* and *Chow* in further view of *Sofer et al.*, U.S. Patent Publication No. 20020012351 [*“Sofer”*].

Claim 86

Pepe as modified by *Chow* and *Sofer* discloses the sending means and the storing means and the controlling means comprises at least one server in the visited network [*Sofer*, Fig. 1 «item 32», 0015: *Sofer* discloses a visited network comprising a gateway where a gateway is analogous to a server | 0016: disclosing that the visiting gateway has a database for storing | 0018: disclosing that the visiting gateway controls access | 0021: disclosing that the visiting gateway sends messages].

Pepe does not disclose that the sending means, the storing means, and the controlling means comprises at least one server. However, such a feature was well known in the art at the time of Applicant's invention as evidenced by *Sofer*.

In a similar field of invention, *Sofer* is directed to controlling access to services on a home network when visiting another network [abstract]. *Sofer* also discloses a gateway (i.e., server) as part of the visited network that sends messages, stores subscriber information, and controls access to services.

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It would have been obvious to one of ordinary skill in the art to have modified *Pepe*'s invention to include *Sofer*'s gateway. Such a modification to include *Sofer*'s gateway into *Pepe* is an example of combining prior art elements (*Sofer*'s gateway and *Pepe*'s system) according to known methods to yield predictable results. See MPEP § 2143.

Claims 88 and 89

Pepe as modified by *Chow* and *Sofer* discloses the visited network according to claim 87 and the method according to claim 1, in which the at least one server is further configured to send to the home network the requested level or type of access to be provided to the subscriber as an access type indicator which identifies a type of access network at which the subscriber is registered [*Sofer*, 0052: disclosing a short code that indicates the type of access to services requested by the subscriber].

See rejection of claim 86 for reasons to combine *Pepe* and *Sofer*.

F. Claims 90, 92, and 94-96 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bharatia*, U.S. Patent Publication No. 20010031635 in view of *Chow*.

Claims 90 and 92

As to claim 90, *Bharatia* in view of *Chow* discloses a method comprising:
in a home network comprising at least one server [*Bharatia*, 0016: disclosing a packet switched wireless network as the subscriber's home network | 0090], storing for a given subscriber a plurality of subscriber profiles [*Chow*, column 7 «line 61» to column 8 «line 21»:
disclosing a user may have multiple service profiles based on the services to which the subscriber is subscribed], each subscriber profile indicating a different type or level of access for

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which the given subscriber is authorized [*Chow*, column 8 «lines 5-43»: disclosing that the specific service profile describes the type of service access available to the user];

in response to the home network receiving from a visited network an application level registration message identifying the given subscriber and a requested level or type of access to be provided by the visited network to the given subscriber [*Bharatia*, 0077: disclosing the CSCF (which is located in the home network) processes application level registration requests | 0081, 0083: disclosing receiving information relating to the subscriber and requested services | 0112], the home network selecting from the stored plurality of subscriber profiles a selected subscriber profile which indicates a level or type of access that is authorized for the given subscriber [*Bharatia*, 0112: disclosing selecting a user profile & *Chow*, column 8 «lines 5-43»: disclosing selecting a particular profile from a plurality of profiles]; and

sending from the home network to the visited network the selected subscriber profile [*Bharatia*, 0112, 0115: disclosing requesting and receiving a subscriber profile].

As noted in the foregoing mapping, *Bharatia* does not expressly disclose that one subscriber may have multiple profiles in the home network. However, such a feature was well known in the art at the time of Applicant's invention as evidenced by *Chow*.

Like *Bharatia*, *Chow* is directed to an invention for providing access to services to a subscriber in a visited network. *Chow* further discloses that a subscriber may establish multiple profiles that specify different types of access to services based on, for example, the user's location.

It would have been obvious to one of ordinary skill in the art to have modified *Bharatia*'s invention to include multiple profiles for a single subscriber as taught in *Chow*. Such a

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modification would improve *Bharatia*'s system because it would allow a subscriber to establish appropriate profiles for different situations that the subscriber is in.

Claim 92 is rejected for at least the same reasons set forth for claim 90.

Claim 96

Bharatia as modified by *Chow* discloses the authorized level or type of access authorizes specific connection supplementary services [*Chow*, , column 8 «lines 23-43»].

See the rejection of claim 1 for reasons to combine *Bharatia* and *Chow*.

G. Claims 91 and 93 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bharatia* and *Chow* in further view of *Sofer*.

Bharatia as modified by *Chow* and *Sofer* discloses the method according to claim 90 and network of claim 92, in which the received requested level or type of access to be provided by the visited network to the given subscriber comprises an access type indicator which identifies a type of access network at which the subscriber is registered [*Sofer*, 0052: disclosing a short code that indicates the type of access to services requested by the subscriber].

Bharatia does not disclose an access type indicator. However, such a feature was well known in the art as evidenced by *Sofer*. Specifically, *Sofer* discloses a received type of access to be provided by a visited network comprises a short code that identifies that service to be accessed (i.e., access type indicator).

It would have been obvious to one of ordinary skill in the art to have modified *Bharatia*'s invention to include *Sofer*'s access type indicators. Such a modification to include *Sofer*'s gateway into *Pepe* is an example of combining prior art elements (*Sofer*'s short codes for identifying services and *Pepe*'s mobile service provisioning system) according to known methods to yield predictable results. See MPEP § 2143.

H. Claim 94 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Bharatia and Chow in further view of Lupien.

Bharatia as modified by Chow and Lupien discloses the authorized level or type of access authorizes a specific degree of bandwidth in communications [*Lupien*, column 14 «lines 25-35»: disclosing incorporating bandwidth information for a subscriber | column 11 «lines 21-40»].

It would have been obvious to one of ordinary skill in the art to have modified *Pepe* and *Chow*'s service profiles to include degree of bandwidth information as described in *Lupien*. Modification of a service profile to include additional information concerning the services provided to a subscriber is not a novel step because such a modification is an example of combining prior art elements (*Chow*'s service profile and *Lupien*'s service profile comprising bandwidth information) according to known methods to yield predictable results. See MPEP § 2143.

I. Claim 95 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Bharatia and Chow in further view of Rai.

Bharatia as modified by Chow and Rai discloses the authorized level or type of access authorizes a specific degree of security in communications [*Rai*, column 24 «lines 13-25»: disclosing each subscriber is defined a security context which authorizes a degree of security (e.g., type of encryption) for communications.

It would have been obvious to one of ordinary skill in the art to have modified *Bharatia*'s mobile service provisioning system to include *Rai*'s security contexts. Such a modification would improve *Bharatia*'s system by allowing subscriber-specific defined security in communications.

V. CONCLUSION

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOHM CHANKONG whose telephone number is (571)272-3942. The examiner can normally be reached on Monday to Friday [10 am - 6 pm].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thu Nguyen can be reached on (571)272-6967. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DOHM CHANKONG/
Primary Examiner, Art Unit 2452